

Remarks:

Reconsideration of the application, as amended herein, is respectfully requested.

Claims 2 - 21 are presently pending in the application.

Claims 2, 3, 17, 20 and 21 have been amended.

In item 1 of the above-identified Office Action, the claims were objected to because claims 3 and 21 were duplicates. Claim 21 has been amended to depend from independent claim 20, thus claims 3 and 21 are no longer believed to be duplicates.

In item 3 of the above-identified Office Action, claims 2, 8, 9, 11, 13 and 20 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U. S. Patent No. 6,826,454 to Sulfstede ("**SULFSTEDE**").

In item 5 of the Office Action, claims 15 - 16 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **SULFSTEDE**. In item 6 of the Office Action, claims 15 - 16 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **SULFSTEDE** in view of U. S. Patent No. 5,582,236 to Eike et al ("**EIKE**"). In item 7 of the Office Action, claims 6 - 7 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **SULFSTEDE** in view of U. S. Patent No. 5,816,059 to Ficchi, Jr, et al ("**FICCHI**"). In item 8 of

the Office Action, claims 10 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over SULFSTEDE in view of U. S. Patent No. 4,859,932 to Whitley ("WHITLEY"). In item 9 of the Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over SULFSTEDE in view of U. S. Patent No. 5,612,616 to Earle ("EARLE"). In item 10 of the Office Action, claim 19 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over SULFSTEDE in view of EIKE and further in view of FICCHI.

Applicant respectfully traverses the above rejections.

More particularly, Applicant's independent claims 2 and 20, and claims depending therefrom, are believed to not be anticipated by the SULFSTEDE reference.

More particularly, Applicant's independent claim 2 has been amended to recite, among other limitations:

a test circuit for testing at least one of continuity and voltage, said test circuit including an interface for selective connection with an element to be tested.
[emphasis added by Applicant]

Applicant's independent claim 20 has been amended to recite, among other limitations:

a test circuit for testing at least one of continuity and voltage , said test circuit including a pair of test probes for selective connection with an element to be tested between said pair of test probes.
[emphasis added by Applicant]

Additionally, both of Applicant's claims 2 and 20 recite, among other limitations, **a separate controller circuit for controlling the HVAC system**. As such, Applicant's invention of claims 2 and 20, includes a test circuit, which is not the controller circuit, which includes an interface (claim 2) or a pair of test probes (claim 20) which can be selectively connected with an individual element of the system to be tested, and not, necessarily, while testing the HVAC system. An example of this is given on page 9 of the substitute specification of the instant application, which states:

As illustrated at the bottom of FIG. 5, when the circuit tester via the detachable test leads 30a, 30b and probes 32, 35 are brought into contact **with a metallic object such as a fuse 50**, the buzzer should emit an audible sound heard through the device casing holes (12 of FIG. 1) **if the fuse 50 is good**.
[emphasis added by Applicant]

As such, using Applicant's device, a technician is able to test **individual elements of the system** for one of voltage or continuity, using its particularly claimed test interface (or pair of test probes). **This is not the case with the device disclosed in SULFSTEDE.**

Contrary to Applicant's claimed invention, which can be connected to the system or to individual elements, the device disclosed in SULFSTEDE can only be connected to, and determine continuity for, the system using tap board cable 100 or the motor using motor cable 102. See Fig. 5 of SULFSTEDE. The tap board cable 100 and motor cable 102 of SULFSTEDE, cannot be used to selectively interface with a chosen element of the system or a subpart of the motor, to determine voltage or continuity. Neither the tap board cable 100 of SULFSTEDE, nor the motor cable 102 of SULFSTEDE can be selectively connected to individual components, (i.e., elements) of SULFSTEDE, to test for continuity or voltage, as recited by Applicant's claims 2 and 20, but rather, are either connected to the system and/or to the motor).

Further, the device disclosed in SULFSTEDE additionally contains a power-pin jack connection 76 (See Fig. 2 of SULFSTEDE) and a second power-pin jack connection 84 (See Fig. 3 of SULFSTEDE). Col. 5 of SULFSTEDE, lines 58 - 60, states "[t]he pin-jack connections enable the analyzer to be used in the 'standalone' mode". As such, it is believed that the power-pin jacks 76 and 84, used to connect the device 10 of SULFSTEDE to a 24 volt power supply 110 (See Figs. 7 and 8) for stand alone operation, are, likewise, not Applicant's claimed interface for selective connection with an element to

be tested. For example, the 24 volt power supply 110, located between the two pin-jack connections of **SULFSTEDE**, is not the **element** being tested.

In fact, the device disclosed in **SULFSTEDE** is an **analyzer** for the system, as a whole, much like a digital analyzer for checking the electronic operating system of a motor vehicle. **SULFSTEDE** does not include an **interface** for **selective** connection to an element that allows it to test **individual elements** of the system, as claimed in Applicant's claim 2, or a **pair of probes** for testing an element therebetween, as claimed in Applicant's claim 20, but only a tapboard cable to **non-selectively** connect the analyzer of **SULFSTEDE** to the HVAC system and a motor cable to connect the analyzer of **SULFSTEDE** to a motor. **SULFSTEDE** neither teaches, nor suggests, an interface (claim 2) or pair of probes (claim 21) that is able to selectively connect the device of **SULFSTEDE** to individual **elements** of an HVAC system (i.e., an individual fuse rather than the system or motor, as a whole), to test the individual **element** for one of continuity or voltage.

As such it is believed that Applicant's claims 2 and 20 are believed patentable over the cited **SULFSTEDE** reference.

Further, Applicant respectfully disagrees that the **SULFSTEDE** and **EIKE** references, taken alone, or in combination, disclose Applicant's **flashlight** of claims 3, 17 and 21.

As stated on page 5 of the Office Action, **SULFSTEDE** does not disclose a **flashlight** and a **flashlight switch**. However, contrary to the allegation made in the Office Action, Applicant respectfully disagrees that the **EIKE** reference teaches or suggests Applicant's claimed **flashlight**.

In common parlance, a "flashlight" is understood to be a light used to illuminate a scene or area. When one goes to the store to purchase a **flashlight**, or batteries for your **flashlight**, it is commonly understood that one speaks of a portable, electric light that illuminates a scene or area at which the bulb is directed. An LED used as an indicator, or a flashing light, as alleged in the Office Action, is not a "flashlight", as that term is commonly understood or as that term is used in the instant application. As understood in the art a light that is flashing is not the same as a flashlight, which, under the common understanding of the term, includes a light that is constant while the flashlight switch is closed, so as to provide constant illumination. A review of the **flashlight circuit** in Fig. 3 of the instant application shows that Applicant's claimed **flashlight** operates in accordance

with the common understanding of the term **flashlight**.

Further, as pointed to by its name, an indicator does not illuminate an area, but merely lights up to indicate a condition, and thus, is not a **flashlight**.

As shown in Fig. 1 of the instant application the flashlight portion of the controller, light bulb L3, is positioned so as to be directed towards, and illuminate, an area during use, and thus, is a "**flashlight**", as that term is commonly used. To make it even more clear that Applicant's use of the term **flashlight** is per the common use of that term, Applicant has amended claims 3, 17 and 21 to explicitly state that the claimed **flashlight** is for illuminating an area at which the **flashlight** is directed. This is supported by the common usage of the term **flashlight**, by the Applicant's specification and, more particularly, by Applicant's Fig. 1, which shows the bulb L3 positioned so as to illuminate an area (i.e., positioned from a face of the controller perpendicular to the control face), rather than positioned, or used, as an indicator.

Applicant respectfully disagrees that **EIKE**, or **SULFSTEDE**, teaches or suggests a **flashlight** for illuminating an area at which the **flashlight** is directed. Rather, status lamps 50, 40 of **SULFSTEDE**, cited in the Office Action as allegedly representing Applicant's claimed "**flashlight**", are merely

status lamps that is lit to indicate a condition. See Col. 5 of **SULFSTEDE**, lines 1 - 13. Similarly, the alarm display 46 of Fig. 8 of **EIKE** is an indicator that merely flashes to indicate an alarm. There is no teaching or suggestion in **SULFSTEDE** or **EIKE** that the status lamps/indicator LEDs of those references, used merely to indicate a condition, are or can be used to illuminate an area at which it is directed. Rather, it is the illumination of the indicator, itself, that is taught to be the important feature of the status lamps/indicator LEDs of **SULFSTEDE** and **EIKE**. As such, Applicants claims 3, 17 and 21 are believed to be patentable over the **EIKE** and **SULFSTEDE** references, taken alone, or in combination.

Further, Applicant's independent claim 17 specifically defines a particular relationship between the **flashlight source** (L3 of Fig. 1 of the instant application) and the front panel of the controller, upon which the controls are found. More particularly, as shown in Fig. 1 of the instant application, the **flashlight source** L3 extends from a top face of the controller, while the switch controls for the controller (i.e., switches SW1 - SW6) extend from a front face. This relationship is specifically claimed in Applicants claim 17. The **SULFSTEDE** reference neither teaches, nor suggests, that the **status lamps** (50 of Fig. 1 of **SULFSTEDE**), equated in the

Office Action to Applicant's claimed flashlight source, extends from a different face as the testor switches, as required by Applicant's claim 17 (i.e., top face vs. front face). Rather, both SULFSTEDE and EIKE disclose the indicator lights, which are alleged in the Office Action to equate to Applicant's flashlight source, extend through the same face as the tester or controller buttons/switches. The reason for this is clearly so that the user of the devices of SULFSTEDE and EIKE can see if the indicators are lit, while manipulating the buttons and switches. Thus, it would be contrary to the purpose of the SULFSTEDE and EIKE indicators to locate them on a different face from the controller/tester switches. In fact, locating the controller/tester switches on a different face from the indicator LEDs of SULFSTEDE and EIKE would reduce the efficacy of those devices and defeat the purpose of including the indicators, as they would be difficult to use (one would have to activate a switch and then rotate the device to see if an indicator lit on a different face of the device). Contrary to the indicators of SULFSTEDE and EIKE, Applicant's claim 17 requires a flashlight source on a different face from the switches, so as to illuminate an area at which the flashlight source is directed (i.e., a work area) while the controller is in use (i.e., illuminating a work area while using the controller). To modify the teachings of the SULFSTEDE and EIKE references to relocate their taught

indicators to a different face, would reduce the efficacy of those devices and destroy the teachings of those references. As such Applicant's claim 17 is further believed patentable over the **EIKE** and **SULFSTEDE** references, taken alone, or in combination.

Further, it is believed that the **EIKE**, **FICCHI**, **EARLE** and **WHITLEY** references, cited in combination with **SULFSTEDE** and/or **EIKE**, against certain dependent claims, do not cure the above described deficiencies of the **SULFSTEDE** and **EIKE** references. For example, there is no motivation in **SULFSTEDE**, **EARLE** or **WHITLEY** to combine the teachings of **EARLE** or **WHITLEY** with **SULFSTEDE** to produce an HVAC circuit analyzer including a separate test device with an interface for testing voltage or continuity of an element, as claimed by Applicant in claims 2 and 20. Rather, the **SULFSTEDE** reference would tend to teach against such a combination. **SULFSTEDE** discloses, in col. 5, lines 25 - 27, an in-line mode of operation wherein the analyzer operates to verify "the continuity of the control functions", and thus, the teachings of **SULFSTEDE** would not lead, and would probably dissuade, one of skill in the art from adding a **second test circuit** (i.e., the circuits of **EARLE** or **WHITLEY**) to its existing analyzer.

It is accordingly believed that none of the references, whether taken alone or in any combination, teach or suggest the features of claims 2, 17 and 20. Claims 2, 17 and 20 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 2, 17 and 20. Additionally, the dependent claims 3 and 21 are believed to be patentable because they depend from allowable independent claims, as well as for the reasons discussed above, in the current preliminary amendment.

In view of the foregoing, reconsideration and allowance of claims 2 - 21 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Additionally, the present is being filed in connection with a Request for Continuing Examination ("RCE") and a three month extension of time, counted from the mailing date of a final Office Action in the above-named case. As such, please consider the present as a petition for a three (3) month extension of time, and please provide a three (3) month

extension of time, to and including, December 1, 2005, to permit the filing of the RCE and the present preliminary amendment.

The extension fee for a small entity for a period of three (3) months pursuant to Section 1.136(a) in the amount of \$510.00 in accordance with Section 1.17 is enclosed herewith.

Please provide any additional extensions of time that may be necessary and charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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